

**SYMES**

Appl. No. 09/960,728

March 15, 2005

**AMENDMENTS TO THE DRAWINGS**

The attached sheet of drawings includes changes to sheet 3/4. This sheet, which includes Figs. 3 and 4, replaces the original sheet including Figs. 3 and 4.

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**REMARKS/ARGUMENTS**

Claims 1-15 stand rejected in the outstanding Official Action. Claims 1-15 remain in this application. Applicants previously submitted Rule 116 amendment including formality corrections and claim amendments was denied entry in view of the claim amendments. This response includes the formality amendments without the claim amendments.

Applicant has amended the title of the invention to be descriptive of the SIMD processing set out in Applicant's independent claims, i.e., the combination of portions of two data words with a single instruction.

The Examiner correctly notes that the arrows at the top right on Figure 4 (directly underneath the letter "k") should point to the left, and Applicant encloses herewith a replacement sheet correcting that drawing.

Claims 14 and 15 contain multiple objections under the provisions of 35 USC §112 (second paragraph). As the Examiner has denied entry of the previous amendment correcting claims 14 & 15, the proposed amendment has been withdrawn.

Claim 15 is rejected in section 16 of the Official Action as allegedly failing to comply with the written description requirement of 35 USC §112 (first paragraph). Specifically, claim 15 is alleged to recite a computer-readable medium which is not disclosed in Applicant's specification. It is noted that the change in language in order to recite a "computer-readable medium" is a result of the Examiner's rejection of claim 15 in the previous Official Action at page 6, section 14. Having amended claim 15 as suggested by the Examiner, the Examiner now rejects the claim based upon the amendment. Reconsideration of the rejection is respectfully requested.

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Moreover, Applicant's specification at page 4, lines 8-9 clearly discloses a "computer program product storing a computer program for controlling a general purpose computer" which, to all of those having ordinary skill in the art, means a "computer-readable medium" which stores the computer program for controlling a general purpose computer in the manner of Applicant's claims. Accordingly, any further objection or rejection of claim 15 is respectfully traversed.

Claims 1-12, 14 and 15 stand rejected under 35 USC §102(b) as being anticipated by Intel ("IA-64 Application Developer's Architecture Guide" May 1999). Applicant notes that at least the copy Intel provided by the Patent Office included only pages 7-117, 135, 150, 158, 169 and 182-184. As a result of the partial copy, it is entirely possible that there are other and more apparent reasons why Intel is not a reference against these claims under the provisions of 35 USC §102. However, even in view of the partial copy of the Intel document, it is apparently not an anticipatory reference.

For example, the Examiner at page 6 of the Official Action admits that "Intel's portions are modified before they are combined." The Examiner suggests that he uses the word "comprising" in Applicant's claim as a rationale for otherwise ignoring the teaching of the Intel reference. The Examiner's rationale is seriously flawed for the following reasons. Applicant's independent claim 1 specifies three elements, i.e., (i) a shifting circuit; (ii) a bit portion selecting and combining circuit; and (iii) an instruction decoder. As a limitation on the instruction decoder, it performs an operation upon the data words Rn and Rm to yield a value given by the recited three-step process.

It is noted that the phrase "said apparatus comprising" refers to the three structures recited in the claim. The three method steps serve to define the value provided by the instruction

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decoder. As will be readily apparent, any modification of the portions recited in the method for determining the value will change the value which is otherwise specified in claim 1.

The Examiner admits that in the Intel teaching the values "are modified before they are combined." As a result, they cannot possibly be combined so as to provide the value recited in Applicant's claim. The burden on the Examiner is to establish where each of Applicant's claimed elements is set out in the Intel reference. Regardless of the use of the term "comprising" the burden is on the Examiner to establish where in the prior art applicants apparatus claim elements and method claim steps are shown. The existence of the inclusive term "comprising" does not permit the Examiner to ignore the requirements of 35 USC §102 and avoid having to point out where and how the prior art teaches all claimed elements and method steps. Additionally, the Examiner may not ignore portions of the cited prior art which would lead those of ordinary skill "away" from the claimed invention.

The Examiner has admitted that Intel does not teach an instruction decoder for performing an operation upon a data word  $R_n$  and a data word  $R_m$  where the operation provides "a value given by" the sequence of recited steps (the admission is in the concession "Intel's portions are modified before they are combined." End of section 19 in Final Rejection). As a result, quite clearly Intel fails to disclose or render obvious the subject matter of Applicant's independent claim 1.

Additionally, claim 15 specifies a computer program for controlling a computer to perform the steps of decoding and executing an instruction that provides the value where the value is defined in the same manner as the value in claim 1. Because this is missing from Intel's disclosure (as admitted by the Examiner), independent claims 14 and 15 cannot possibly be anticipated by Intel.

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As a result of the above, because independent claims 1, 14 and 15 define over the Intel reference, all claims dependent thereon similarly define over Intel and any further rejection thereunder is respectfully traversed.

Claim 13 stands rejected under 35 USC §103 as obvious over Intel as previously applied. Claim 13 ultimately depends from claim 1, and therefore because Intel fails to disclose or render obvious the subject matter of claim 1, claim 13 is clearly patentable in view thereof.

**Entry of the Amendment under Rule 116**

Entry of the above Amendment under Rule 116 is respectfully requested. In this second Rule 116 submission, applicant has withdrawn the previously proposed claim amendments which were the basis for denial of the previous Rule 116 amendment. However, applicant submits the formality corrections in order to reduce the issues on Appeal.

It is noted that the Examiner objected to the first amended title offered in the November 24, 2004 amendment and only made his suggestion as to what he wanted for a title in the final rejection. The drawing correction was prompted by the Examiner's objection which was first noted only in the final rejection. Entry of these revised drawings is requested in view of the examiner's insistence that they are required ("the objection to the drawings will not be held in abeyance").

Accordingly, entry of the above formality amendments is believed appropriate, in that they do not raise new issues requiring further examination and/or search, they do not offer any objectionable "new matter," and they do eliminate issues of objection and therefore should be entered pursuant to Rule 116.

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Having responded to all objections and rejections set forth in the outstanding Official Action, it is submitted that claims 1-15 are clearly patentable over the cited prior art and notice to that effect is respectfully solicited. In the event the Examiner is of the opinion that a brief telephone or personal interview will facilitate allowance of one or more of the above claims, he is respectfully requested to contact Applicant's undersigned representative.

Respectfully submitted,

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